

**REMARKS/ARGUMENTS**

In view of the following remarks, the applicants respectfully submit that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action.

**Rejections under 35 U.S.C. § 103**

Claims 2-8, 11-17, 20-24, 26 and 27 stand rejected under 35 U.S.C. § 103 as being anticipated by U.S. Patent No. 5,994,710 ("the Knee patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 6, 8 and 12 are not rendered obvious by the Knee patent because the Knee patent neither teaches, nor suggests, that the light emitted from a first light source and reflected from a surface onto an image pickup device is used in an act of capturing a plurality of image parts, and the light emitted from a second light source and reflected from

the surface onto an image pickup device is used in the act of determining position information. One skilled in the art would not have been motivated to modify the Knee patent as proposed by the Examiner.

The Examiner concedes that the Knee patent fails to teach a second light source. (See Paper No. 20070502, page 3.) In an attempt to compensate for this admitted deficiency, the Examiner concludes that the applicants have not disclosed any specific advantage or criticality to having a second light source, and therefore the addition of a second light source is an obvious matter of design choice. (See Paper No. 200705020, page 3.) The Examiner further concludes:

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include a second light source with the capturing device of KNEE because **-as the Applicant also points out** in section [0017]- the addition of a separate light source or imaging element **could be** provided without destroying the essential elements of the apparatus. [Emphasis added.]

(Paper No. 20070502, page 3.) The applicants respectfully submit that this rejection is improper for a number of reasons.

First, as to the Examiner's conclusion that the applicants have not disclosed any specific advantage or criticality to having a second light source, the applicants noted that one light source may illuminate

a document at a first angle of incidence for purposes of position determination, and another, separate, light source may illuminate the document at another angle of incidence for purposes of scanning. This advantageously permits position determination to be performed with light striking the document at a low angle of incidence (to enhance the texture of the surface), while simultaneously permitting scanning to be performed with light striking the document at a higher angle of incidence (to enhance scanning). There is nothing in the Knee patent that would teach, suggest, motivate, make it obvious to try, or through common sense lead one of ordinary skill to add a second light source. Consequently, the applicants do not see how the proposed modification is an obvious design choice. Thus, for at least this reason, it is respectfully submitted that claims 6, 8 and 12 are not rendered obvious by the Knee patent. Since claims 2, 3, 7 and 26 depend from claim 6, since claims 11 and 27 depend from claim 8, and since claims 13-17 and 20-24 depend from claim 12, it is further respectfully submitted that these dependent claims are similarly not rendered obvious.

With regard to the Examiner's conclusion that the addition of a separate light source or imaging element **could be** provided without destroying the essential elements of the apparatus, **as the Applicant points out**, the fact that something **could be** done does not make it obvious to do so. The fact that the applicants' own application teaches something should not be used against the applicants. To reiterate, there is nothing in the Knee patent that would teach,

suggest, motivate, make it obvious to try, or through common sense lead one of ordinary skill to add a second light source. Thus, claims 6, 8 and 12 are not rendered obvious by the Knee patent for at least this additional reason. Since claims 2, 3, 7 and 26 depend from claim 6, since claims 11 and 27 depend from claim 8, and since claims 13-17 and 20-24 depend from claim 12, these claims are similarly not rendered obvious.

Further regarding claims 7 and 11, the Examiner concedes that the Knee patent, even as modified, fails to teach that the light emitted from the first light source has a larger angle of incidence with the surface than the light emitted from the second light source. To compensate for this admitted deficiency, the Examiner takes official notice that it would have been obvious to one in the art, that when including a second light source, it would be positioned at a different angle from the first light source in order to reflect more light to a wider area. (See Paper No. 20070502, page 4.) The applicants respectfully submit that this rejection is improper.

MPEP 2144.03 (A) states, in pertinent part:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art

reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

MPEP 2144.03 (B) states, in pertinent part:

If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.

Since the applicant is unaware of any art supporting the Examiner's official notice that it would have been obvious to provide a second light source at a different angle of incidence to reflect more light onto a wider area, the applicants believe and respectfully submit that the noticed fact is not common knowledge or well-known in the art. The applicants demand that the Examiner produce authority for her assertion of official notice. That is, the applicants demand that the Examiner produce documentary evidence in the next Office action if the rejection of claims 7 and 11 is to be maintained.

### Conclusion

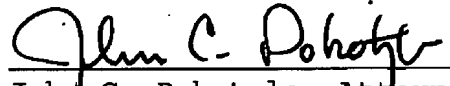
In view of the foregoing remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants

request that the Examiner pass this application to issue.

Any arguments made in this response pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

October 10, 2007

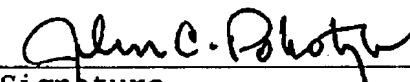
  
John C. Pokotylo, Attorney  
Reg. No. 36,242  
Tel.: (732) 542-9070

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

John C. Pokotylo

Type or print name of person signing certification

  
Signature

October 10, 2007  
Date